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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
SCOTT JACOBS;

GROUP: 330

Serial Number:
10/727,061

Examiner:

Filed
December 2, 2003

Docket No. 130136

For:
IMPROVED MOUTHPIECE

Enclosed please find three (3) copies of a Reply Brief in the subject application. Also enclosed is a certificate of mailed signed and dated October 24, 2005. No fee is due.

DATE: October 24, 2005

Respectfully submitted
SCOTT JACOBS

By his Attorney

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SCOTT JACOBS;

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Examiner:

Camtu Nguyen

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REPLY BRIEF

To the Commissioner of Patents and Trademarks:

Sir:

Please enter the Reply Brief in response to the Examiner's Answer mailed August 25, 2005.

(1)

REAL PARTY IN INTEREST

The Examiner's Answer concurs with this portion of the Appeal Brief.

(2)

RELATED APPEALS AND INTERFERENCES

The Examiner's Answer concurs with this portion of the Appeal Brief.

(3)

STATUS OF CLAIMS

The Examiner's Answer concurs with this portion of the Appeal Brief.

(4)

STATUS OF AMENDMENTS

The Examiner's Answer concurs with this portion of the Appeal Brief.

(5)
SUMMARY OF THE INVENTIOIN

The Examiner's Answer concurs with this portion of the Appeal Brief.

(6)
ISSUES

The Examiner's Answer concurs with this portion of the Appeal Brief.

(7)
GROUPING OF CLAIMS

The Examiner's Answer concurs with this portion of the Appeal Brief.

(8)
Reply Argument

I.

Claim 1, inter alia, contains the limitations that the outer try be conformable to the user's teeth and the inner tray function as a cushion to protect the teeth from damage when the user encounters a blow to the jaw area. Despite what the Examiner has stated in the Examiner's Answer, neither of the cited references, nor any other prior art, alone or in combination, suggests or otherwise makes obvious the use of this combination of two portions in one mouthguard because neither reference discloses nor shows a cushion material as the inner tray. The Franz trays are stated (column 2, lines 59 ff.) as being of the type that holds in impression material and in fact hold putty rope 20, which is an impression material. In use, both trays (column 5, lines 42 ff.) are filled with a rope of putty and the patient bites down. The putty is then hardened (column 5, line 60). Nowhere Franz is there any recognition of the need for a cushion material to be in contact with the user's teeth.

Putty takes the form of the teeth and is hardened, and cannot function as a cushion for repeated use such as during a hockey game or the like. Franz is not even concerned with protecting teeth but, rather, is intended to prevent snoring during sleep.

Adell does actually relate to a mouthguard, but it is for dental use and not to protect the user during athletic competition. There is, again, no recognition of the need for a cushion material to be in contact with the user's mouth. Use of the Adell design would put the user at greater risk of damage during impact, say with an elbow from a competitor, because it would bruise or cut the inside of the user's mouth and would do nothing to absorb impact.

The combination of Franz and Adell, taken as a whole, does not suggest the claimed subject matter because nowhere in either reference is (1) the concept of a cushion layer in contact with the teeth, (2) the use of an outer tray that does conform to the teeth (as neither Franz nor Adell do) to position the cushion portion in a place to protect the user. The rope of Franz and the liner of Adell cannot function as a cushion and both are conformed to the teeth of the user. The outer trays of Franz and Adell are not conformed to the user but serve to hold the conformable inner layer. Thus both references are the direct opposite of the presently claimed invention.

This point cannot be over emphasized. Rather than an inner tray that conforms to the teeth of the user, Applicant recites an inner tray of a gel that cushions the teeth but does not conform upon heating. Frantz has putty that conforms to the patient's teeth but does not cushion. Adell has liner 12 that conforms to the teeth and does not cushion the teeth upon impact.

Only Applicant has made a mouthguard that repeatedly cushions the teeth by presenting a gel that is not formed into an impression of the user's teeth and that has an outer component that (1) holds the cushioning gel against the teeth and (2) itself is conformed by heating to the user's mouth for a more precise fit and careful positioning of the cushioning gel. One can not combine the references to find features that are not only not present but which are direct opposites to the claimed features.

II.

The second issue on appeal is whether the third reference, Ueno, discloses a material set forth in the rejected claims and use of that material in the combination of Franz in view of Adell is obvious. The Examiner has stated that, "Ueno teaches the ball members (3) is made of thermoplastic elastomer (e.g. styrene block copolymer) which offers a softening point of higher than 100 °C, higher than that of the mouthpiece." Thus the Examiner is suggesting that a material be inserted in the primary reference combination that doesn't soften even in boiling water. How can it cushion an elbow to the jaw?

In summary, it is respectfully submitted that none of the references have an outer tray, which does not directly contact the user's teeth, that does conform when heated to give a better fit, and none of the references have an inner tray that does not conform to the teeth but instead cushions the teeth on impact. Both claimed elements are the direct opposite in the cited art.

Favorable consideration is earnestly solicited and allowance of the claims is respectfully urged.

Respectfully submitted
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(9)

APPENDIX
CLAIMS ON APPEAL

The Examiner's Answer concurs with this portion of the Appeal Brief.